

REMARKS

The Office action of 30 March 2009 (Paper No. 20090323) has been carefully considered. Allowance of claim 76 is noted with appreciation.

Status of the Claims

Claims 54 through 64 and 71 through 76 are pending, of which claims 54 through 64 and 71 through 75 are rejected. Claim 76 is allowed.

Listing of the Claims

Pursuant to 37 CFR §1.121(c), the claim listing, including the text of the claims, will serve to replace all prior versions of the claims, in the application.

Amendment of the Claims

No claims are amended by this Paper.

Rejection Under Obviousness-Type Double Patenting

- I. Claims 59 through 64 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 19 through 21, 23, 24, 28 and 39 of Jordan, U.S. Patent No. 6,820,616 B1.**

In support of this rejection, the Examiner asserted that,

“Although the conflicting claims are not identical, they are not patentably distinct from each other because for example, instant claim 59 has everything as recited in the patented claim 21 including a controller. The only difference is the recitation of a control panel with a “mode selection switch.” However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a control panel to US’616’s controller so that the user can adjust the settings via the switches. Note that the controller controls the operation of the gas system, which comprises the first, second, and third units and the common gas system (see patented claim 21), it is considered that the controller is coupled to all the units

and the common gas system for providing the controlling function. The limitation of control panel is also found in the patented claim 39. In addition, having a switch in a control panel is a well-known feature for controlling a system. The limitation of a switch is also found in the patented claim 39. Thus, any infringement over the patent would also infringe on the instant claims.

The limitations of claim 60 can be found in patented claim 20 (again it would have been obvious to include a control panel with a mode selection switch for the device with four testing units instead of three). The limitations of claim 61 can be found in patented claim 21. The limitations of claim 62 can be found in patented claim 23. The limitations of claim 63 can be found in patented claim 24. The limitations of claim 64 can be found in patented claim 28.”

Claims 59-64

This rationale of the factual evidence of record is misleading, and technically inaccurate because none of claims 19-21, 23, 24 or 28 of U.S. Patent No. 6,820,616 B1 define Applicant's:

“a control panel coupled to each of the first unit, the second unit, the third unit, and the common gas system, the control panel including a mode select switch for controlling flow of air compressed by the first compressor or the second compressor”

as is set forth in parent independent Claim 59. Only claim 39 of Applicant's '616 defines a “control panel” defined as “having a plurality of switches and indicators *for controlling* the tests for said *first, second, third and fourth units*. Claim 39 is utterly devoid of any definition of either pending claim's “the control panel including a mode select switch for controlling flow of air compressed by the first compressor or the second compressor.”

Moreover, no limitation within claims 19-21, 23, 24, 28 or 39 of U.S. Patent No. 6,820,616 B1 define Applicant's,

“a common gas system integrated into said first unit and said second unit, said common gas system characterized by a first compressor and a second compressor producing a lower flow and a higher pressure than said first compressor, said first compressor compressing air when a pressure of an item to be tested is below a preset pressure

value, and said second compressor compressing the air when the pressure of the item to be tested is equal to or over the preset pressure value.”

In view of this two-way distinctiveness, there is no factual evidence within this administrative record to support a conclusion at law of obviousness of parent independent claim 59, and its dependent claims 60 through 64. Withdrawal of this rejection is respectfully urged.

Claims 54-58 and 71-75 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3, 4, 7, 9, 17, 21, 26, and 27 of U.S. Patent No. 6,820,616 B1 in view of Sherrod (US 5,979,444 A).

The rationale given in Paper No 20090323 in support of this conclusion of law, is that,

“Although the conflicting claims are not identical, they are not patentably distinct from each other because for example, instant claim 54 has everything as recited in the patented claim 1 except the recitation of a “regulator enable valve.” However, regulator enable valves are well known and commonly used in the art. For example, Sherrod discloses a breathing apparatus with a regulator enable valve (22) coupled to a pressure regulator (90) to control the pressure of air flowing through the regulator. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a regulator enable valve as taught by Sherrod and is well known in the art to US’616’s system so that the pressure of air flowing through the regulator can be accurately controlled to provide breathable air at a safe pressure to a user.

The limitations of claim 55 can be found in patented claim 4. The limitations of claim 56 can be found in patented claim 7. The limitations of claim 57 can be found in patented claim 9. The limitations of claim 58 can be found in patented claim 17. The limitations of claim 71 can be found in patented claims 26 and 27.

The limitations of claims 72, 73, and 75 can be found in patented claim 21. As discussed above, the addition of a regulator enable valve as taught by Sherrod would have been obvious to one of ordinary skill in the art at the time the invention was made as would have the addition of a control panel to US'616's controller so that the user can adjust the mode settings via the switches (and accordingly the valves). The limitations of claim 74 can be found in claims 26 and 27.”

Applicant respectfully disagrees with this rationale.

Claims 54-58 and 71

This rationale is incomplete and is factually insufficient to support the Examiner’s conclusion at law of obviousness, because none of claims 1, 3, 4, 7, 9, 17, 21, 26, and 27 of U.S. Patent No. 6,820,616 B1 modified according to Sherrod US 5,979,444 A defines such features of claims 54 through 58 as Applicant’s:

“a first compressor compressing air, said first compressor coupled to each of the first system and the second system,

“a second compressor compressing the air, said second compressor coupled to the second system,”

in combination with Applicant’s,

“a regulator enable valve coupled to the regulator, the regulator enable valve controlling pressure of air flowing through the regulator”

Modification of the primary reference to incorporate a “regulator” according to Sherrod ‘444 fails to remedy these deficiencies. Accordingly, there is no *prima facie* showing of obviousness-type double patenting.

Under the doctrine of obviousness-type double patenting, all differences between the claims must be identified before a conclusion at law of obviousness made be reached. This was not done in Paper No. 20090323. Consequently, the conclusion of obviousness is not supported by the facts introduced into the administrative record, and this rejection may not be maintained.

Claims 72-75

The rationale of Paper No 20090323 given as factual evidence in support of this rejection, states that:

“The limitations of claims 72, 73, and 75 can be found in patented claim 21. As discussed above, the addition of a regulator enable valve as taught by Sherrod would have been obvious to one of ordinary skill in the art at the time the invention was made as would have the addition of a control panel to US'616's controller so that the user can adjust the mode settings via the switches (and accordingly the valves). The limitations of claim 74 can be found in claims 26 and 27.”

Applicant respectfully disagrees because the Examiner's proposed combination of claims 21, 26 and 27 modified according to Sherrod '444 fails to define Applicant's:

“control panel coupled to each of the first unit, the second unit, and the gas system, the control panel including a mode select switch for controlling flow of air compressed by the first compressor or the second compressor, the mode select switch turning on or off the first flow valve depending on a mode selected by the mode select switch.”

These differences were not identified or considered in Paper No. 20090323. Consequently, no *prima facie* showing of obviousness-type double patenting has been made from the facts placed into evidence in this administrative record, and this rejection may not be maintained. Its withdrawal is respectfully requested. Such action is urged.

A. Authority to reject a claim filed in a divisional application under the doctrine of non-obviousness double patenting

Applicant continues to observe that the claims are prohibited under 35 U.S.C. §121 from being rejected by obviousness type double patenting because the instant application is a divisional application of the parent case US 6,820,616. The fact that once again, the Office has lost or misplaced documents, and that the Office has no record of an application data sheet (“ADA”) being submitted at the filing of the instant application. It is unclear where the ADA copied on page 26 of

the appeal brief is located in the application record. The requirements for claiming benefit (i.e., either within the ADA or in the first sentence of the specification) are laid out in the final rejection of 9/27/2007. Accordingly, this application was not properly claimed as a divisional application within the required time period and as such, the claim for priority was not granted (i.e., there is no record of an ADA and the specification was not amended with the required four or sixteen month time period).

The Examiner's assertion that "the Office will make a double patenting rejection because a patentee is entitled to only a single patent for an invention" has no basis at law where, as here, in imposing a requirement for restriction, the Office has declared that the application contains more than one independent and distinct invention.

Moreover, the form of a claim, whether method, apparatus, product-by-process or article of manufacture is simply a drafting technique that has no bearing upon the subject matter encompassed between two Groups identified in the requirement under 35 U.S.C. §121. The assertion by Paper No. 20090323 only the method claimed in instant claim 76 is prohibited form being rejected by the parent patent by 35 USC §121 because it is a separate and distinct invention from the patented apparatus" is nonsense, and has no authority in law.

In view of the above, it is submitted that the claims of this application are in condition for allowance, and early issuance thereof is solicited. Should any questions remain unresolved, the Examiner is requested to telephone Applicant's attorney.

Respectfully submitted,



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